

## REMARKS

By this amendment, claim 4 has been canceled. Claims 1-3 and 5-9 have been amended. New claims 10-17 have been added. Claims 1-3 and 9-17 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

### Objection to the Claims

Claims 8-9 were objected to because of informalities. As now presented, claims 8-9 have been amended, as appropriate, in independent form. Objection to the claims is now believed overcome.

### Rejection under 35 U.S.C. §101

Claims 1-2 and 6 were rejected to under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention. As presented herein, claim 1 has been amended, in part, to associate forming and providing with an encoder. In a similar manner, claim 6 has been amended, in part, to associate reading with a decoder. Accordingly, the rejection of claims 1-2 and 6 is now believed overcome.

Claims 4-5 were rejected to under 35 U.S.C. §101 as being directed to nonstatutory subject matter. With respect to claim 4, the same has been deleted herein, thus rendering the rejection thereof now moot. With respect to claim 5, as presented herein, claim 5 has been amended, in part, to recite a storage medium having stored thereon a signal within a packetized elementary data stream, the packetized elementary data stream being executable by a reproduction device for causing the reproduction device to reproduce main data of the packetized elementary data stream. Accordingly, the claim is no longer believed directed to non-statutory subject matter. Withdrawal of the rejection is requested.

**Rejection under 35 U.S.C. §103**

Claim 1 recites a method of providing a signal within an elementary data stream to be encoded via an encoder, the signal representing main data, the main data including embedded data, the main data being provided with a main data descriptor for signaling content included in the main data, the method comprising:

forming, via the encoder, an embedded data descriptor for signaling content included in the embedded data; and

providing, via the encoder, the embedded data descriptor within the elementary data stream outside (i) the main data including the embedded data and (ii) the main data descriptor of the elementary data stream, the embedded data descriptor further for signaling embedded data content that comprises enhancement data for enhancing the main data available in the elementary data stream during a reproduction of the main data by a reproduction unit configured to recognize the embedded data descriptor.

Support for claim 1 (as well as for claims 3, 5-9) can be found in the specification at least on page 2, lines 13-14; page 3, lines 28-31; page 4, lines 10-12; and FIG. 2.

As presented, claim 1 clearly articulates a novel and non-obvious method of providing a signal within an elementary data stream. For example, as discussed in the specification on page 2, lines 10-19, according to the claimed method, by providing the embedded data descriptor outside the main data and thus also outside the embedded data, the main data remains compatible (i.e., backward compatible) and it is further not necessary to access the embedded data itself to get a description of the embedded data. As a result, elementary streams with embedded data have two respective descriptors, one for the main data and another for the embedded data. The main data, the embedded data, the main data descriptor and the embedded data descriptor are all

present in the same transport signal. Advantageously, in one embodiment, the signal is an elementary audio data stream, wherein the embedded data is enhancement data to enhance the audio available in the elementary data stream.

Claims 1-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kim (US 7340762; hereinafter "Kim"). With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that the **Kim** reference is defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness ...*

It is submitted that, in the present case, the examiner has not factually supported a *prima facie* case of obviousness for at least the following reasons.

#### 1. The Reference Does Not Teach the Claimed Subject Matter

The **Kim** reference cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since **Kim** does not teach a method of providing a signal within an elementary data stream that includes "*forming ... an embedded data descriptor ... and providing ... the embedded data descriptor within the elementary data stream outside (i) the main data including the embedded data and (ii) the main data*

descriptor of the elementary data stream, the embedded data descriptor further for signaling embedded data content that comprises *enhancement data* for enhancing the *main data* available in the elementary data stream during a reproduction of the main data ..." (emphasis added) as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

With respect to **Kim**, the examiner indicates in the office action on page 3, in lines 6-8 of the last paragraph, that while "Kim fails to explicitly show the main data descriptor outside the embedded data, Kim does disclose the main data can be embedded in other descriptors (**Kim**: column 7, lines 1-5)." The **Kim** reference at column 6, line 66 through column 7, lines 1-5 states: "Furthermore, the core information of the Broadcasting Schedule Information (BSI) (channel number, program number, start time, running time, and end time) for the Main Program can also be embedded in other descriptors within the MPEG-2 signal syntax, such as the *video\_descriptor* descriptor, depending on the specific system design of the particular digital television network." As now presented, it is unknown to the Applicant how this disclosure of **Kim** could be deemed equivalent to a method of providing a signal within an elementary data stream as now presented that includes "forming ... an embedded data descriptor (*It should be noted that as presented in claim 1, the embedded data descriptor is for signaling content in the embedded data; the embedded data is included within the main data; and a main data descriptor is for signaling content in the main data*) ... and providing ... the embedded data descriptor within the elementary data stream outside (i) the *main data* including the embedded data and (ii) the *main data descriptor* of the elementary data stream, the embedded data descriptor further for *signaling* embedded data content that comprises *enhancement data* for enhancing the *main data* available in the elementary data stream during a reproduction of the *main data* ..." as recited in claim 1.

For this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should

be withdrawn.

## 2. The Combination is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Kim** reference cannot be applied to reject claim 1 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, the **Kim** reference neither teaches, or even suggests, the desirability of the combination since the reference does not teach a method of providing a signal within an elementary data stream that includes "forming ... an embedded data descriptor ... and providing ... the embedded data descriptor within the elementary data stream outside (i) the main data including the embedded data and (ii) the main data descriptor of the elementary data stream, the embedded data descriptor further for signaling embedded data content that comprises enhancement data for enhancing the main data available in the elementary data stream during a reproduction of the main data" as specified above and as claimed in claim 1.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claim 2 depends from and further limits independent claim 1 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Claims 3 and 5-9 contain limitations similar to those of claim 1. Accordingly, for similar reasons as stated with respect to overcoming the rejection of claim 1, claims 3 and 5-9 are believed allowable and an early formal notice thereof is requested. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

### **New Claims**

New claims 10-17 have been added to provide more complete claim coverage for the embodiments of the present application. Support for new claims 10-17 can be found in the specification, at least on page 2, lines 17-19 and page 3, lines 28-31. Claims 10-11 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Claims 12-13 depend from and further limit allowable independent claim 3 and therefore are allowable as well. Claims 14-15 depend from and further limit allowable independent claim 6 and therefore are allowable as well. Claims 16-17

depend from and further limit allowable independent claim 7 and therefore are allowable as well.

### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 3 and 5-9 are in condition for allowance. Claims 2 and 10-11 depend from and further limit independent claim 1 and therefore are allowable as well. Claims 12-13 depend from and further limit independent claim 3 and therefore are allowable as well. Claims 14-15 depend from and further limit independent claim 6 and therefore are allowable as well. Claims 16-17 depend from and further limit independent claim 7 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-3 and 5-17 is requested.

Respectfully submitted,

/Michael J. Balconi-Lamica/

Michael J. Balconi-Lamica  
Registration No. 34,291  
for Edward Goodman, Reg. No. 28,613

Dated: December 12, 2009  
Philips Intellectual Property & Standards  
345 Scarborough Road  
Briarcliff Manor, New York 10510  
Telephone: 914-333-9611  
Facsimile: 914-332-0615  
File: NL021091US1

a-32658.315